

REMARKS

Applicant has carefully reviewed the Office Action mailed October 19, 2006 and offers the following remarks to accompany the above amendments.

Claim 21 has been amended in accordance with the interview conducted with the Examiner and Applicant's representative, Rick Witcher, on September 14, 2006.

Before addressing the rejections, Applicant provides a brief overview of the invention. The present invention is designed to simplify a user's interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device that has computer readable memory associated therewith. The portable memory device has an appropriate interface through which it may communicate with the computing device during the computing session. The memory contains computer readable software that automatically executes on the computing device during the computing session. In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction. In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the present invention. To further protect the user's privacy, the software of the present invention subsequently removes the financial information from the computing device. For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device cannot retrieve private information about the previous user.

On page 3 of the Office Action mailed October 19, 2006, in the heading, claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable "over Pitroda (US 5,884,271) in view of TERGEON (US 20020029254) and further in view of Official Notice." Applicant initially notes that the Examiner cites U.S. Patent Application Publication No. 2002/0029254 A1 as being to "TERGEON"; however, that reference number is for Davis. In any event, in the body of the rejection, it appears as though the Examiner is actually using Pitroda, Arnold (US 6,950,857), Turgeon (US 2003/0014371 A1), and Official Notice to reject claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27. Applicant responds as if that was the intended rejection.

To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

First, Pitroda is maybe the least pertinent reference used in a rejection in the prosecution of this case. Applicant fails to see why the Patent Office is using the Pitroda reference. It teaches almost none of the elements of the claimed invention. The Patent Office admits as much by bringing in all of the secondary references. Pitroda is directed to a universal electronic transaction card (“UET card”) that is capable of serving as a number of different credit cards, bank cards, ID cards, employee cards, medical and health care management cards, and the like. The UET card includes storage elements, an input interface, a processor, a display, and a communications interface. In one embodiment, transactional and account information may be transferred between the UET card and a personal or mainframe computer.

Claim 1 recites a portable device comprising:

- a) a body;
- b) memory within the body containing software and financial account information;
- c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
- d) the software adapted to execute on the host computing device to instruct the host computing device to:
 - i) recognize financial account fields in a web page during a browsing session;
 - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
 - iii) automatically execute on the host computing device in association with the computing session; and

- iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

Pitroda fails to teach at least the following elements of claim 1 in combination:

- 1) software within the body of the portable device that is adapted to execute on the host computing device to instruct the host computing device;
- 2) the software adapted to automatically execute on the host computing device in association with the computing session;
- 3) the software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device;
- 4) the software adapted to execute on the host computing device to instruct the host computing device to remove records pertaining to the computing session from the host computing device upon termination of the computing session.

The Patent Office asserts that Pitroda, col. 10, lines 40-50, and Figure 4 teaches software adapted to execute on the host computing device to instruct the host computing device.

Applicant respectfully traverses. Column 10, lines 40-50 of Pitroda merely discloses that a home PC may interact with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes. Pitroda discloses software for interfacing between the home PC and the UET card for reading information from the card, but it does not indicate that this software is resident on the UET card. Thus, this software is not software within the body of the portable device that is adapted to execute on the host, as in the claimed invention. Moreover, the software disclosed in Pitroda is just for reading information from the card; there is no mention of the software instructing the host computer to do anything, as is required in the claimed invention. Thus, Pitroda fails to teach or suggest software adapted to execute on the host computing device to instruct the host computing device, as required by the present invention. Therefore, Pitroda fails to teach the limitation for which it is cited.

The Patent Office admits that Pitroda fails to teach software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device (Office Action mailed October 19, 2006, p. 3). The Patent Office claims that Arnold discloses using an

ancillary computing device to analyze web page fields and fill in the appropriate fields. *Ibid.* Applicant respectfully submits that Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. In Arnold, there is a site map database that contains information which maps the fields of a personal information database to frames of a Web page. A robot program at a data center where the databases are located correlates the personal information fields with the frames of the Web page and sends the personal information to a palmtop computer. The palmtop computer uses the information to automatically populate the frames of a Web clipping that represents a Web page (Arnold, col. 1, lines 47-61; see Figure 6). The Web clipping is not the same as a Web page (*Id.* at col. 6, lines 13-64).

The robot program in Arnold that correlates the personal information fields with the frames of the Web page is located in data center 320 (Arnold, Figure 6; see also col. 6, line 65 through col. 7, line 12). Thus, the software of Arnold is not software that executes on the host computing device, as claimed in the present invention. In addition, the robot program of Arnold does not instruct the host computing device to recognize and fill in financial account fields in a web page. In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). Finally, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. In Arnold, the personal information comes from personal information database 350 in data center 320 (*Id.* Figure 6; see also col. 7, lines 13-17; and col. 8, lines 30-32). The personal information is stored in the personal information database 350 because it is considered undesirable to store confidential information within the palmtop computer (*Id.* at col. 7, lines 13-21). Thus, Arnold does not disclose filling in the financial account fields with financial account information from a portable device since the personal information in Arnold is stored in a secure database. In fact, if anything Arnold teaches away from the present invention, since it teaches that it is undesirable to store personal information on a portable device. MPEP § 2141.02. Based on the above, it is clear that Arnold does not teach the element for which it is cited.

The Patent Office also admits that Pitroda does not teach that the software is adapted to automatically execute on the host computing device in association with the computing session (Office Action mailed October 19, 2006, p. 4). However, the Examiner asserts that auto run capability is old and well known in the art as shown in Applicant's Specification at page 6, line 30 through page 7, line 15. Then the Examiner takes Official Notice that automatically executing a remote device on a host device is old and well known in the art (Office Action mailed October 19, 2006, p. 4). The Examiner then states that it would have been obvious to include in Pitroda an auto-execute program because it "will simplify the accessing of the remote application by not requiring the devices application to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device." *Ibid.*

For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). Applicant respectfully submits that the Patent Office has failed to provide a proper motivation to modify Pitroda to include the auto-run feature alleged to be old and well-known in the art. In this case, the Patent Office has failed to provide any actual evidence to support the stated motivation to combine Pitroda with what is alleged to be well-known in the art. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

Moreover, as discussed above, Pitroda does not teach software adapted to execute on the host computing device to instruct the host computing device, as required by the present invention. Pitroda merely discloses a UET card that has information on it. There is no software on the UET card that executes on a host computing device to instruct the host to perform the steps of the claimed invention. Thus, there is no need for Pitroda to include an autorun feature. In fact, Applicant respectfully submits that adding an autorun feature to Pitroda would not work since there is no software on the UET card that could execute on a host device to instruct the host device to do anything. In addition, trying to add something like an auto-run feature to Pitroda would impermissibly change the principle of operation of Pitroda or render Pitroda unsatisfactory for its intended purpose. MPEP § 2143.01. For the above reasons, it would not be obvious to modify Pitroda to add an auto-run feature.

Pitroda also does not teach or suggest “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” The Patent Office admits that Pitroda does not teach this element, but asserts that Figure 5, step 521 of Turgeon shows the recited element (Office Action mailed October 19, 2006, p. 4). Turgeon does disclose that during the Web transaction, after the information is retrieved from the CD, and the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the **software provided by the portable device** that instructs the host computing device to remove records pertaining to the computing device, as required by the claimed invention. Finally, the flushing of the memory in Turgeon is not done “in association with termination of the computing session.” Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (*Ibid.*; see also steps 522-570 of Figures 5b-5d). Thus, Turgeon does not teach software adapted to “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” Therefore, claim 1 is patentable for this additional reason.

Moreover, Applicant respectfully submits that the Patent Office has failed to provide a proper motivation to combine Turgeon with Pitroda, Arnold, and the auto-run feature alleged to be old and well-known in the art. The Patent Office alleges that the stated motivation to combine Turgeon with Pitroda is to “improve the security of sensitive data by not allowing the data to reside on a device that is not secure.” (Office Action mailed October 19, 2006, p. 4). However, the Patent Office has failed to provide any actual evidence to support the stated motivation to combine Turgeon with Pitroda, Arnold, and the auto-run feature alleged to be old and well-known in the art. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

In addition, the stated motivation does not compel the combination. First, the UET card already includes security features to prevent unauthorized use (Pitroda, Abstract). Thus, Pitroda does not need to improve the security of data. Accordingly, the stated motivation does not apply to Pitroda. Since the stated motivation is inapplicable to Pitroda, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn for this additional reason.

Finally, Pitroda discloses that a home PC may interact with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes. Pitroda discloses software for interfacing between the home PC and the UET card for reading information from the card (Pitroda, col. 10, lines 40-50). Thus, in order for Pitroda to perform transactional analysis for tax review, summary, or budgeting purposes, the PC would need the information for some period of time. Thus, flushing the PC to remove data would render Pitroda unsuitable for its intended purpose. MPEP § 2143.01. Therefore, the combination is improper for this further reason.

Claims 4, 5, 16, 17, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitroda in view of Turgeon and U.S. Patent No. 6,199,077 B1 to Inala et al. (hereinafter “Inala”) and further in view of Official Notice. Applicant respectfully traverses. The standards for obviousness are set forth above.

First, Applicant respectfully submits that the Patent Office has failed to provide a proper motivation to combine Inala with Pitroda and the other cited art. The Patent Office alleges that the stated motivation to combine Inala is “because this would save the user time and provide a automatic and transparent access to restricted websites to the user.” (Office Action mailed October 19, 2006, p. 7). However, the Patent Office has failed to provide any actual evidence to support the stated motivation to combine Inala with Pitroda and the other cited references. Instead, the Patent Office just makes the sort of conclusory statement without evidentiary support that the Federal Circuit found insufficient in *Dembiczak*. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

Even if adding Inala to the combination were proper, a point Applicant does not concede, the combination still does not teach each and every element of the claimed invention. Claims 4, 16, and 24 depend from claims 1, 13, and 21, respectively, and add the additional limitation of

“wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.” As set forth above, the combination of Pitroda, Arnold, Turgeon, and what was asserted to be old and well-known in the art still does not teach or suggest each and every element of claim 1. Inala does not cure the deficiencies of the other references in this regard. Thus, claims 4, 16, and 24 are patentable based on their dependency on claims 1, 13, and 21, respectively. In addition, Inala merely discloses an auto-login feature. This is not equivalent to the claimed “wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.” The login information in Inala is not stored in a portable device. The Patent Office fails to explain how the UET card of Pitroda would successfully incorporate the auto login feature without using Applicant’s specification as a blueprint. And even if the auto log-in feature were somehow incorporated into the UET card of Pitroda, the combination still would not teach or suggest software on a portable device that “is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site,” as required by claims 4, 16, and 24. Thus, the combination does not teach each and every element of claims 4, 16, and 24, and claims 4, 16, and 24 are patentable for this additional reason.

Likewise, claims 6, 17, and 25 add the further limitation of “wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.” The Patent Office asserts that Pitroda teaches a bookmark stored on the portable device (Office Action mailed October 19, 2006, p. 7). Applicant has reviewed Pitroda and finds no mention of a bookmark being stored on the UET card. Inala does disclose a Password-All Portal and software that can be used to manage a user’s bookmarks (Inala, col. 8, lines 25-41). However, the bookmarks mentioned in Inala are not stored on a portable device. In addition, neither Pitroda nor Inala, alone or in combination, teach or suggest software on the portable device that is further adapted “to instruct the host computing device to make the bookmark accessible by a

browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser," as required by claims 5, 17, and 25. Thus, the combination does not teach each and every element of claims 5, 17, and 25, and claims 5, 17, and 25 are patentable for this additional reason,

Claims 1-7, 9-19, and 21-27 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Arnold and Turgeon and further in view of Official Notice. Applicant respectfully traverses. The standards for obviousness are set forth above.

Applicant notes the interview with Applicant's representative Rick Witcher and Examiner Mark Fadok on September 26, 2006, in which the Davis reference was discussed, primarily with respect to claim 1. Applicant clarifies the Interview Summary provided by the Examiner in that the Davis reference was identified as an anticipatory reference under 35 U.S.C. § 102(e). No other references were mentioned in the Interview. Applicant argued that Davis lacked several elements of the claimed invention as set forth in claim 1, and focused on the lack of teaching of software on the portable device that is adapted to automatically execute on the host computing device in association with the computing session because that seemed to be the easiest argument to understand. The Examiner was unable to point to anything in Davis that showed the software automatically executing on the host. Applicant also pointed out that Davis failed to teach that the software was adapted to execute on the host computing device to instruct the host to perform the claimed steps. In addition, Applicant pointed out that Davis was prior art only if Davis could claim priority to one of the provisional applications and queried whether the provisionals to which Davis claim priority adequately supported the disclosure of recognizing and filling in the financial account fields in the web page with the financial account information from the portable device. The Examiner indicated that he had reviewed the provisional and believed it contained all of the features of the instant claims, but did not point to any specific portion of the provisional(s) that showed the recognizing and filling in of the financial account fields. Finally, Applicant pointed out that Davis did not teach the software on the portable device adapted to execute on the host and instruct the host computing device to remove records pertaining to the computing session from the host computing device in association with termination of the computing session.

In the present Office Action, the Patent Office admits that Davis does not teach several elements of the claimed invention. The Patent Office does state that paragraph 0036 of Davis

discloses software on a portable device that is adapted to execute on the host computing device to instruct the host computing device (Office Action mailed October 19, 2006, p. 8). Applicant respectfully disagrees. Davis discloses a smart card device 410 that is configured with the functionality of a server to provide for operation and control of multiple applications (Davis, paragraph 0036). The smart card device can be configured through an interface with the access device 430. As a result, the smart card device can organize, manage, and store information locally in a portable device. However, there is no indication in Davis that the applications on the smart card device are adapted to execute on the host computing device to instruct the host computing device, as required by the claimed invention. The applications on the smart card act locally and do not execute on the host to instruct the host to perform the steps of the claimed invention. The Patent Office asserts that paragraph 0043 of Davis teaches processing applications from the smart card on a client device. Applicant respectfully disagrees. Paragraph 0043 of Davis discloses that the smart card device may provide user data to data management component 450 of the access device 430. User data is not software. The smart card device of Davis merely provides data to the access device; it does not contain software adapted to execute on the host computing device to instruct the host computing device. Similarly, in paragraph 0059, Davis discloses that a user financial application 604 on the smart card device can be used to import financial information to another web site or vendor. However, there is no teaching or suggestion that the user financial application 604 is executed on the access device to instruct the access device to import the financial device. Accordingly, Davis fails to teach or suggest software on a portable device that is adapted to execute on the host computing device to instruct the host computing device to perform the claimed steps. Thus, Davis does not even teach the element for which it is cited. Therefore, the combination fails to teach or suggest each and every element of the claimed invention, and the claims are allowable.

The Patent Office now admits that Davis does not disclose software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device (Office Action mailed October 19, 2006, p. 8). Instead, the Patent Office relies on Arnold to teach this limitation. As discussed above, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable

device. In Arnold, there is a site map database that contains information which maps the fields of a personal information database to frames of a Web page. A robot program at a data center where the databases are located correlates the personal information fields with the frames of the Web page and sends the personal information to a palmtop computer. The palmtop computer uses the information to automatically populate the frames of a Web clipping that represents a Web page (Arnold, col. 1, lines 47-61; see Figure 6). The robot program in Arnold that correlates the personal information fields with the frames of the Web page is located in data center 320 (*Id.* Figure 6; see also col. 6, line 65 through col. 7, line 12). Thus, the software of Arnold is not software that executes on the host computing device, as claimed in the present invention. In addition, the robot program of Arnold does not instruct the host computing device to recognize and fill in financial account fields in a web page. In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). Finally, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. In Arnold, the personal information comes from personal information database 350 in data center 320 (*Id.* Figure 6; see also col. 7, lines 13-17; and col. 8, lines 30-32). The personal information is stored in the personal information database 350 because it is considered undesirable to store confidential information within the palmtop computer (*Id.* at col. 7, lines 13-21). Thus, Arnold does not disclose filling in the financial account fields with financial account information from a portable device since the personal information in Arnold is stored in a secure database. In fact, if anything, Arnold teaches away from the present invention, since Arnold teaches that it is undesirable to store personal information on a portable device. MPEP § 2141.02. Based on the above, it is clear that Arnold does not teach the element for which it is cited.

The Patent Office also admits that Davis does not teach that the software is adapted to automatically execute on the host computing device in association with the computing session (Office Action mailed October 19, 2006, p. 9). However, the Examiner asserts that auto run capability is old and well known in the art as shown in Applicant's Specification at page 6, line 30 through page 7, line 15. Then the Examiner takes Official Notice that automatically executing a remote device on a host device is old and well known in the art (Office Action

mailed October 19, 2006, p. 9). The Examiner additionally states that it would have obvious to include an auto-execute program in Davis because it “will simplify the accessing of the remote application by not requiring the device to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device.” *Ibid.*

Applicant notes that this is the same motivation given to modify Pitroda. Applicant believes this indicates that the Patent Office is not providing the requisite actual evidence to support the motivation to modify the reference. In any event, Applicant submits that the Patent Office has failed to provide a proper motivation to modify Davis to include the auto-run feature alleged to be old and well-known in the art for similar reasons set forth above with respect to Pitroda. The Patent Office has failed to provide any actual evidence to support the stated motivation to combine Davis with what is alleged to be well-known in the art. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

Moreover, similar to the discussion above with respect to Pitroda, Davis does not teach software on the portable device that is adapted to execute on the host computing device to instruct the host computing device, as required by the present invention. Davis discloses a smart card device that has information and applications on it. There is no software on the smart card device that executes on a host computing device to instruct the host to perform the steps of the claimed invention. Thus, there is no need for Davis to include an autorun feature. In fact, Applicant respectfully submits that adding an autorun feature to Davis would not work since there is no software on the smart card device that executes on a host device to instruct the host device to do anything. In addition, trying to add something like an auto-run feature to Davis would impermissibly change the principle of operation of Davis or render Davis unsatisfactory for its intended purpose. MPEP § 2143.01. For the above reasons, it would not be obvious to modify Davis to add an auto-run feature.

The Patent Office admits that Davis also does not teach or suggest the element “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” Instead, the Patent Office asserts this limitation is shown by Figure 5, step 521 of Turgeon (Office Action mailed October 19, 2006, p. 9). As discussed previously, Turgeon does disclose that during the Web transaction, after the

information is retrieved from the CD, and the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the **software on the portable device** that instructs the host computing device to remove records pertaining to the computing device, as required by the claimed invention. Finally, the flushing of the memory in Turgeon is not done “in association with termination of the computing session.” Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (*Ibid.*; see also steps 522-570 of Figures 5b-5d). Thus, Turgeon does not teach software adapted to “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” Therefore, claim 1 is patentable for this additional reason.

Moreover, Applicant respectfully submits that the Patent Office has failed to provide a proper motivation to combine Turgeon with Davis, Arnold, and the auto-run feature alleged to be old and well-known in the art. The Patent Office alleges that the stated motivation to combine Turgeon with Davis is to “improve the security of sensitive data by not allowing the data to reside on a device that is not secure or will be usable by another at a latter time.” (Office Action mailed October 19, 2006, p. 9). Applicant notes that this is the same motivation given to modify Pitroda. Applicant believes this indicates that the Patent Office is not providing the requisite actual evidence to support the motivation to modify the reference. In any event, Applicant submits that the Patent Office has failed to provide a proper motivation to modify Davis to include the auto-run feature alleged to be old and well-known in the art for similar reasons set forth above with respect to Pitroda. In particular, the Patent Office has failed to provide any actual evidence to support the stated motivation to combine Turgeon with Davis, Arnold, and the auto-run feature alleged to be old and well-known in the art. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

In addition, the stated motivation does not compel the combination. First, the smart card device of Davis can already be configured to facilitate secured transactions (Davis, paragraphs 0066-0068). Thus, Davis does not need to improve the security of data. Accordingly, the stated motivation does not apply to Davis. Since the stated motivation is inapplicable to Davis, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn for this additional reason.

In summary, the Patent Office has failed to properly support the motivation to combine the various references with the requisite actual evidence. Instead, the Patent Office is improperly attempting to pick and choose the elements of the invention from various pieces of prior art and then use hindsight to combine them. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”). Thus, the combinations are improper. Even if the combinations were proper, a point Applicant does not concede, none of the cited references, alone or in combination, teach or suggest a portable device that has software on the portable device that is adapted to automatically execute on a host computing device in association with a computing session, where the software is adapted to execute on the host and instruct the host to recognize financial account fields in a web page during a browsing session, fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction, and in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Thus, the claims of the present invention are allowable.

Claim 1 was used in the analysis above. However, claims 13 and 21 contain similar limitations and are patentable for at least the same reasons. Claims 2-7 and 9-12 depend from claim 1 and contain all of the limitations of claim 1. Claims 14-19 depend from claim 13 and contain all of the limitations of claim 13. Claims 22-27 depend from claim 21 and contain all of the limitations of claim 21. Thus, claims 2-7, 9-12, 14-19, and 22-27 are also patentable.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant’s representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,
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